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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/524,881

10/19/2005

William H Shepard

05918-336US1

5888

26161 7590 06/27/2008

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EXAMINER

SALVATORE, LYNDIA

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

06/27/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/524,881	SHEPARD ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lynda M. Salvatore	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10-12, 16, 17 and 32-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 10-12, 16, 17 and 32-40 is/are rejected.
- 7) ☒ Claim(s) 41-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's request for continuing examination (RCE), amendment and accompanying remarks filed 5/14/08 have been fully considered and entered. Claim 1 has been amended and new claims 32-45 have been added as requested. Applicant's remarks are found persuasive to overcome the obviousness type rejections of claims 1-3, 10-12, 16 and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Shepard et al., WO 99/11452 in view of Deka et al., US 2002/0019206 A1. Specifically, it is the position of the Examiner that based on the combination of teachings a lack of motivation exists to combine references. As such, these rejections are hereby withdrawn. In addition, Applicant's amendments are found persuasive to overcome the anticipation rejections of claims 1-3, 12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Shepard et al., WO 00/73063. Specifically, the prior art of Shepard et al., fails to fully anticipate the newly added claim limitations. As such, these rejections are hereby withdrawn. However, Applicant's amendments are not found patentably distinguishable over the prior art Shepard et al., and upon further consideration the following new ground of rejection is set forth herein below.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 10, 12, 16, 17, 32-37, 39 and 40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shepard et al., WO 00/73063.

The published WO document issued to Shepard et al., teach a hook-engagable knit or non-woven material having a basis weight of less than about 4 ounces adhesively laminated to a paper layer (page 2, 1-5, page 3, 1-10 and figure 1C, page 10, 25-33, page 15, 14-30). Said hook and loop material is stabilized with claimed amount of binder set forth in claim 12 in stretched state (page 6, 25-32 and page 2, 10-15). Shepard et al., teach that the surface of the lightweight hook engagable material can be decorated (page 18). Said hook material has a height ranging from .015 to .030 inch (page 19, 1-5). Said non-woven or knit material is also coated with a binder to form a resin film (page 30, 21-page 31, 5). Said non-woven/paper laminate can be employed as decorations or floor coverings (abstract).

With specific regard to claim 3, the recitation of “at least as great as that of 85 pound Kraft paper”, it is the position of the Examiner that such a recitation is not considered a positive limitation in any patentable sense. As such, the Examiner considers the paper taught by Shepard et al., just as stiff as that of 85 lb Kraft paper. If having 85 lb Kraft paper is critical to the novelty of the claimed laminate, then it is suggested that Applicant positively claim 85 lb Kraft paper.

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With regard to claims 1 and 16, it is the position of the Examiner that bulk materials such as the laminate formed by Shepard et al., is commonly packaged and stored in roll form for easy transport. The Examiner does not consider any thing particularly novel about providing the laminate material in roll form. With specific regard to the flexible limitation, it is the position of the Examiner that since textiles and paper materials are inherently flexible, the laminate provided by Shepard et al., is considered flexible unless explicitly evidenced otherwise. Applicant has not claimed any particular paper in independent claim 1. Accordingly, the Examiner maintains that the paper of Shepard et al., would have the claimed flexibility.

With regard to the limitation of building construction laminate, it is the position of the Examiner that said limitation constitutes an intended use limitation not germane to the final product. Since the combination of prior art meets the structural and/or chemical limitations presently set forth there is nothing on record to evidence that the laminate provided by Shepard et al., could not function as a building construction laminate. Applicant is invited to prove otherwise.

With regard to the claimed percentage of areal stretch, Shepard et al., does not specifically teach the claimed percentage of areal stretch, however, it is the position of the Examiner that it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the non-woven material of Shepard et al., with desired areal stretch as function of desired use. It has been held that discovering an optimum value of result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215

Although, the reference does not expressly teach the claimed Gurley stiffness and flexibility, however, it is reasonable to presume that said feature is inherent to the

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laminate of Shepard et al. Support for said presumption is found in the use of like materials such as a paper/fabric laminate, which result in the claimed Gurley stiffness and flexibility. The burden is shifted to Applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed Gurley stiffness and flexibility would obviously have been present once the laminate of Shepard et al., is provided. *In re Best*, 195 UPSQ 433

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shepard et al., WO 99/11452 as applied to claim 1 above and further in view of Deka et al., US 2002/0019206 A1.

Shepard et al., does not explicitly teach employing fibers of 3 denier, however, the published Deka et al., teach a colored loop material comprising a nonwoven hook and loop material adhesively laminated to a paper backing layer (sections 0099, 0100, 0052, 0004 and figure 6). ). Said non-woven material comprises low denier fibers (e.g., 2.8 and 3.5) (section 0058). Deka et al., discloses that low denier fibers provide more fibers per unit area. Said nonwoven hook material is used to form fastening systems in disposable garments and abrasive sheet materials such as sandpaper (section 0001 and 0014).

Therefore, motivated by the desire to provide a fabric laminate with more fibers per unit area, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the non-woven or knit fabric of Shepard et al., with low denier fibers as taught by Deka et al.

5. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shepard et al., WO 99/11452 as applied to claim 1 above and further in view of Kennedy et al., US 5,744,800.

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Shepard et al., does not explicitly teach the use of Kraft paper, however, the patent issued to Kennedy et al., teach a non-woven laminate comprising a Kraft paper layer (abstract and column 9, 55-65). With regard to employing 20-90 lb Kraft paper, Kennedy et al., does not explicitly teach 20-90 lb Kraft paper, however, it is the position of the Examiner that it would be obvious to one having ordinary skill in the art at the time the invention was made to employ a suitable weight of Kraft paper as a function of desired end use. It has been held that discovering an optimum value of result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 UPSQ 215

#### ***Allowable Subject Matter***

6. Claims 41-46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Presently, there are no teachings found in the prior art to provide the laminate and/or film with the additional claimed agents.

#### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lynda Salvatore/  
Primary Examiner  
Art Unit 1794  
6/22/08